

REMARKS

The Official Action mailed December 16, 2005, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicants respectfully submit that this response is being timely filed.

The Applicants note with appreciation the consideration of the Information Disclosure Statements filed on April 2, 2004; June 30, 2004; January 10, 2005; January 27, 2005; March 14, 2005; May 17, 2005; and October 25, 2005.

The Applicants note the partial consideration of the Information Disclosure Statement filed on October 12, 2004 (received by OIPE October 15, 2004). Specifically, in the "OTHER PRIOR ART – NON PATENT LITERATURE DOCUMENTS" section, it appears that the Examiner inadvertently overlooked the citation of the "Office Action dated September 23, 2004 in Application Serial No. 10/852,125." The Applicants respectfully request that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of the Office Action in the '125 application.

The Applicants note the partial consideration of the Information Disclosure Statement filed on March 3, 2005 (received by OIPE March 7, 2005). Specifically, in the "OTHER PRIOR ART – NON PATENT LITERATURE DOCUMENTS" section, it appears that the Examiner inadvertently overlooked the citation of the "Office Action for U.S. Application Serial No. 10/925,980 dated February 7, 2005." The Applicants respectfully request that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of the Office Action in the '980 application.

A further Information Disclosure Statement was submitted on December 8, 2005 (received by OIPE December 12, 2005), and consideration of this Information Disclosure Statement is respectfully requested.

A further Information Disclosure Statement is submitted herewith, and consideration of this Information Disclosure Statement is respectfully requested.

Claims 35-67 were pending in the present application prior to the above amendment. Dependent claims 62-65 have been canceled, and independent claims 35-58 have been amended to better recite the features of the present invention. Accordingly, claims 35-61, 66 and 67 are now pending in the present application, of which claims 35-58 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 2 of the Official Action rejects claims 35, 37, 39, 41, 43, 45, 47, 49, 51, 53, 55 and 57 under 35 U.S.C. § 112, second paragraph, asserting that "the phrase 'filmy' renders the claim(s) indefinite" (page 2, Paper No. 20051209). In response, claims 35, 37, 39, 41, 43, 45, 47, 49, 51, 53, 55 and 57 have been amended by changing "filmy" to "resinous," which is supported in the present specification, for example, by the second to the last paragraph of page 2. The Applicants respectfully submit that amended claims 35, 37, 39, 41, 43, 45, 47, 49, 51, 53, 55 and 57 are definite. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 112 are in order and respectfully requested.

Paragraph 4 of the Official Action rejects claims 35, 37, 39, 41, 43, 45, 60, 66 and 67 as anticipated by U.S. Patent No. 5,229,644 to Wakai et al. Paragraph 5 of the Official Action rejects claims 35, 37, 39, 41, 43, 45, 66 and 67 as anticipated by JP 63-279228 to Nishiki et al. The Applicants respectfully submit that an anticipation rejection cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent claims 35, 37, 39, 41, 43, 45, 47, 49, 51, 53, 55 and 57 have been amended to recite a pair of resinous substrates. The Applicants respectfully submit

Wakai '644 or Nishiki does not teach the above-referenced features of the present invention, either explicitly or inherently.

Since Wakai '644 or Nishiki does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

Paragraph 7 of the Official Action rejects claims 36, 38, 40, 42, 44, 46, 60, 61 and 64-67 as obvious based on the combination of Wakai '644 and U.S. Patent No. 5,627,404 to Takenouchi et al. The Applicants respectfully submit that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. Independent claims 36, 38, 40, 42, 44 and 46 have been amended to recite that at least one of the pair of flexible substrates comprises polyethylene naphthalate, which was previously recited in dependent claim 65. Wakai '644 and Takenouchi, either alone or in combination, do not teach or suggest the above-referenced features of the present invention. Although the Official Action asserts that Takenouchi teaches polyethylene naphthalate at column 3, lines 49-55 (page 5, Paper No. 20051209), Takenouchi does not, in fact, teach or suggest a flexible substrate comprising polyethylene naphthalate. Therefore, Wakai '644 and Takenouchi do not teach or suggest that at least one of the pair of flexible substrates comprises polyethylene naphthalate.

Since Wakai '644 and Takenouchi do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

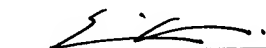
Paragraph 8 of the Official Action rejects claims 47, 49, 51, 53, 55, 57, 59, 60, 66 and 67 as obvious based on the combination of Wakai '644 and U.S. Patent No. 5,821,137 to Wakai et al. Paragraph 9 of the Official Action rejects claims 48, 50, 52, 54, 56, 58-60 and 64-67 as obvious based on the combination of Wakai '644, Takenouchi and Wakai '137. Paragraph 10 of the Official Action rejects claims 61-63 as obvious based on the combination of Wakai '644 and Takenouchi. Paragraph 11 of the Official Action rejects claims 61-63 as obvious based on the combination of Wakai '644, Wakai '137 and Takenouchi.

Independent claims 47-58 have also been amended to recite that at least one of the pair of flexible substrates comprises polyethylene naphthalate. Please incorporate the arguments above with respect to the deficiencies in Wakai '644 and Takenouchi. Wakai '137 does not cure the deficiencies in Wakai '644 and Takenouchi. The Official Action relies on Wakai '137 to allegedly teach "utilizing a laser light comprising excimer

laser light" (page 6, Paper No. 20051209). Wakai '137 appears to teach a glass substrate. However, Wakai '644, Takenouchi and Wakai '137, either alone or in combination, do not teach or suggest that at least one of the pair of flexible substrates comprises polyethylene naphthalate. Since Wakai '644, Takenouchi and Wakai '137 do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Eric J. Robinson
Reg. No. 38,285

Robinson Intellectual Property Law Office, P.C.
PMB 955
21010 Southbank Street
Potomac Falls, Virginia 20165
(571) 434-6789